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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,196	01/23/2007	Yoshiyuki Kono	Q95815	8443
23373 7590 04/16/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/16/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/587,196

Applicant(s)

KONO, YOSHIYUKI

Examiner

Margaret G. Moore

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4, 6 to 9, 11, 12, 16 to 18, 20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 7, 12, 17, 18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 2, 8, 9, 11, 16, 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/2010 has been entered.
2. Applicants' amendment has overcome the rejection noted in the previous office action. The prior art failed to teach or suggest a combination of polyoxoalkylenes in which one has a lower molecular weight than the other, as now required by claim 1. The Examiner updated her search in view of the newly amended claims and makes the following new grounds of rejection.
3. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner cannot find support for the upper limit of .9 (claim 23) or for the hydrocarbon compound of 1 to 20 carbon atoms (claim 24). It is noted that applicants have not indicated where in the specification such limitations are taught.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Okawa et al.

New claim 24 includes a hydrocarbon compound of 1 to 20 carbon atoms having an average of .5 to 1 reactive silyl groups. In other words the silyl group (1) shown in claim 24 is attached to a hydrocarbon compound of 1 to 20 carbon atoms. Such a hydrocarbon compound includes methyl, phenyl and vinyl groups (to name but a few). When there is only one reactive silyl group attached to this hydrocarbon compound, the resulting compound is met by methyl trialkoxysilane, phenyl trialkoxysilane or vinyl trialkoxysilane.

Okawa et al. teach a room temperature curable composition in which a polyether compound having reactive silyl groups is admixed with a silane compound. Please see, for instance, the silylated polyether shown on the bottom of column 4. This contains silyl groups as claimed, having 3 alkoxy groups, and corresponds to claimed polymer (A). In Example 1 such a polymer is mixed with methyltrimethoxysilane, meeting the requirement of a hydrocarbon compound of 1 to 20 carbon atoms having 1 reactive silyl group. This anticipates the claim.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 6, 7, 12, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roesler et al.

Roesler et al. teach a blend of a polyether having two or more reactive silyl groups and a polyether having only one reactive silyl group. See for instance the teachings on column 3, lines 5 and on. Note the reactive amine (I) in the abstract which corresponds to the general formula (1) wherein a is 3. The polyether having two or more reactive silyl groups referred to as a) in Roesler et al. corresponds to claimed polymer (A). The polyether having one reactive silane group referred to as b) in Roesler et al. corresponds to claimed component (B).

The bottom of column 3 teaches various weight ranges for the polymer a) while the bottom of column 7 teaches various weight ranges for the b). These are best shown in claims 13 to 20 of Roesler et al. The molecular weight ranges taught in these claims overlap with the claimed requirement that the molecular weight of organic polymer (B) is lower than the molecular weight of organic polymer (A) by not less than 3,000. As such For instance if one were to pick the specifically taught lower limit of a) of 6,000 and the specifically taught lower limit of b) of 3,000, the resulting combination of polyethers would meet the claimed molecular weight requirement. As such one having ordinary skill in the art would have found this limitation to have been obvious over Roesler et al. and in this manner the claims are rendered obvious.

For claim 3, note formula (III) on column 8.

For claim 4, see column 9, lines 58 and on.

For claim 7, please note that the molecular weight range in Roesler et al. for the polymer b) overlaps substantially with this range.

8. Claims 2, 8, 9, 11, 16 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest such limitations. Specifically there is nothing teaching or suggesting the combination of polymers which are free of a urea or urethane bond. There is nothing suggesting a combination of polymers in which polymer (A) has 3 X groups and polymer (B) has 2 X groups. There is nothing teaching or suggesting the average number of reactive groups as found in claim 23.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
4/12/10